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10/751,565	01/05/2004	Masaaki Ueda	17339	3667

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EXAMINER

JOHNSON III, HENRY M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/751,565	Applicant(s) UEDA ET AL.	
	Examiner Henry M. Johnson, III	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-34 is/are rejected.
- 7) ☒ Claim(s) 7, 9, 13, 15, 20, 22 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed 2/13/2006 have been fully considered but they are not persuasive. Shimmura et al. is interpreted as reading on the claims as previously cited and as cited herein. The use of variable features and relative positions does not overcome art that is capable of assuming the same structure. Further, the wording of the claims allows for very broad interpretation due to it failing clearly define specific apparatus elements. The parallelogram configuration of the moving mechanism is a clear example where two sides are cited. Since a parallelogram has four sides, any two sides can be chosen by an evaluator. Because claims are given their broadest interpretation, precision in wording is necessary to clearly define a structure.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite, as the elements cannot be clearly identified. The moving mechanism is a parallelogram and therefore has four sides, thus first and second sides cannot be determined. Since the first and second sides cannot be identified, the shaft portion location is also unclear. It is also unclear how the supporting mechanism can rotate about the shaft, as it would appear the axis intended is axis 02, which is perpendicular to the shaft.

Claim 1 is indefinite as the structure is dependent on a center of gravity that is variable depending on the medical instrument and an orientation of the holding portion.

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Claim 3 recites the limitation "the center of inclination" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 3, 16, 28 and 31 are indefinite because the claim limitations are dependent on an arbitrary medical instrument that will determine the center of gravity and center of operation. The weight of the instrument, its size and how it is mounted will impact the center of gravity, thus making the claim indefinite. The grasping position of the operator will impact the center of operation.

Claim 16 recites the limitation "the center of inclination" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 is indefinite as it is not clear how the elements are operatively connected, as the term located does not necessarily include a connection or coupling. It is not clear if the support arm (#41) is part of the supporting mechanism or the moving mechanism. With the supporting mechanism being cited as located at the end of the rotating member, the support arm would be included, yet the ball joint is cited as coupling the moving mechanism and the supporting mechanism, indicting it is part of the moving mechanism.

Claim 27 recites the limitation "the moving mechanism" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "the center of inclination" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 31 recites the limitation "the center of inclination" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25, and 27-32 are rejected under 35

U.S.C. 102(b) as being anticipated by

U.S. Patent Application Publication US 2001/0027313 to Shimmura et al. Note this is the application publication of U.S. Patent 6,514,239 previously cited.

Shimmura et al. teach a medical instrument holding apparatus with a portion for holding an instrument (Fig. 1, #

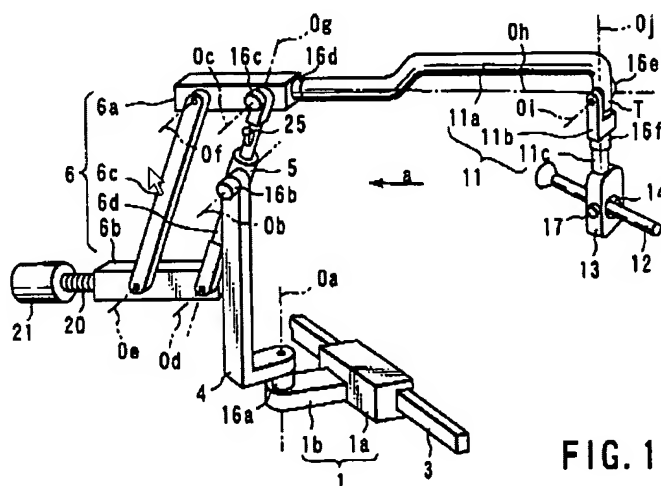


FIG. 1

14), a support arm (Fig. 1, # 11a), a base support (basal portion, Fig. 1, #s 3 & 4), a shaft coupled to the basal support (Fig. 1, # 5), the shaft forming part of a parallelogram moving (moving mechanism) structure (Fig. 1, # 6) with a counterweight (Fig. 1, # 21) to offset the weight of the support arm (Fig. 1, # 11a) and instrument. The mechanism is rotatable about axis 0g (Fig. 1). Arm 6a is clearly shorter than arm 6c of the parallelogram. A ball joint is disclosed that connects the moving portion to an instrument support portion (Fig. 7, #16h). Since the center of gravity of the instrument and support depends on the instrument and the orientation, the ball joint is clearly capable of being oriented in any relation to the center of gravity. An operator may grasp any portion of the support and instrument elements.

Electromagnetic locks as means for braking their respective movable sections are disclosed

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(Fig. 1, #s 16a-16f), with an activating switch on the holding portion (paragraph 0059). A braking means is also disclosed for the ball joint (paragraph 0092). The instrument holding portion is interpreted is capable of being held by an operator and is coupled to the support arm by rotatable joints (Fig. 1, #s 16e & 16f). The upper portion of the parallelogram is shorter than the lower portion with the counterweight and either of the side arms. The counterweight is adjustable via screw threads (Fig. 1, # 20).

The apparatus of Shimmura et al. implicitly has centers of gravity, centers of inclination and forces exerted within the device based on the weights of the instrument and counterweights. Relative positions of apparatus components will vary as the instrument is positioned and can assume limitless configurations. The apparatus is therefore interpreted as capable of the position cited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication US 2001/0027313 to Shimmura et al. Shimmura et al. are discussed above and disclose an endoscope as the medical instrument, but do not specifically teach an optical or imaging system. A skilled artisan knows that endoscopes typically include multiple lumens for instruments and observation during an endoscopic procedure. It would have been obvious to one skilled in the art to include optics and imaging in the instrument as it is common and well known to do so.

Allowable Subject Matter

Claims 7, 9, 13, 15, 20, 22 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Henry M. Johnson, III
Primary Examiner
Art Unit 3739